



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,624	03/23/2001	Walter Canis	END9-2000-0145US1	7110
45092 7590 04/29/2009 HOFFMAN WARNICK LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207				
EXAMINER NEURAUTER, GEORGE C				
ART UNIT 2443		PAPER NUMBER		
NOTIFICATION DATE 04/29/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

09/816,624

Applicant(s)

CANIS ET AL.

Examiner

George C. Neurauter, Jr.

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17, 19-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17, 19-23 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claims 1, 3-17, 19-23, and 25-28 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 April 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-17, 19-23, and 25-28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-17, 19-23, and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3-17, 19-23, and 25-28 recite wherein a plurality of collection tools collect a "specific subset" of device and detail information for a "specific operating system". It is unclear what is considered to be "specific" in the context of the claimed invention.

Claims 1, 3-17, 19-23, and 25-28 further recite "wherein at least one collection tool being configured to collect a different subset of the device identification and detail information for a different operating system from another collection tool". It is unclear whether this "different subset" is related to the "specific subset" previously recited. In the same vein, it is unclear whether the collection tool or a device on the network is the original provider of the "different subset".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-17, 19-23, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5 948 055 to Pulsipher et al in view of US Patent 6 282 175 to Steele et al.

Regarding claim 1, Pulsipher disclosed a system for mapping a network, comprising:

- a collection system for collecting device identification and detail information ("topology data") from devices on the network by querying each device to retrieve the device identification and detail information, wherein the detail information includes device characteristic information and software information, wherein the collection system comprises a collection tool ("network monitor"). (column 7, lines 41-57)

- an analysis system for analyzing the collected device identification and detail information (column 8, lines 7-24)

- a report system for generating a mapping report based on the analyzed device identification and detail information. (column 8, lines 38-49)

Pulsipher did not expressly disclose a timer system for collecting the device identification and detail information at predetermined scheduled times, however, Steele did disclose these limitations (see at least column 2, line 66-column 3, line 15)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Steele

discloses that collecting information concerning the operating system allows identification of what has changed in the configuration of a computer which aids in troubleshooting and management of a computer system network (column 2, lines 1-4). In view of these specific advantages and that the references are directed to collecting device identification and detail information about devices on a network, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Pulsipher and Steele did not expressly disclose a plurality of collection tools, wherein each collection tool is configured to collect a specific subset of the device identification and detail information for a specific operating system, and wherein at least one collection tool being configured to collect a different subset of the device identification and detail information for a different operating system from another collection tool, however, Pulsipher did disclose a collection tool that is configured to collect device identification and detail information from devices on a network as shown above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a plurality of collection tools enabled to collect information from devices on a network including other collection tools since it has been held duplication of parts involves only routine art in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Further, it would have been obvious to enable a collection tool to

collect such information from another collection tools since Pulsipher expressly disclosed that the collection tools had the ability to collect information from devices on a network and to extend this functionality to include other duplicate collection tools would have involved only routine skill in the art.

It further would have been obvious to have a plurality of collection tools collect a specific subset of the device identification and detail information for a specific operating system and wherein at least one collection tool collects a different subset of the device identification and detail information for a different operating system since these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the descriptive material does not patentably distinguish the claimed invention.

Regarding claim 3, Pulsipher and Steele disclosed the system of claim 2.

Pulsipher disclosed wherein the analysis system comprises rules for resolving any conflicts between device identification and detail information collected by at least one collection tool. (column 11, lines 8-19)

Regarding claim 4, Pulsipher and Steele disclosed the system of claim 1.

Pulsipher disclosed wherein the device identification and detail information includes device identities, device types, device addresses, device characteristics, application software installed on the devices, and software characteristics of the devices on the network. (column 7, line 65-column 8, line 6)

Pulsipher does not disclose wherein the device identification and detail information includes operating system software installed on the devices, however, Pulsipher does disclose wherein the device may be a computer (column 7, line 67-column 8, line 2, specifically column 8, line 1).

Steele discloses wherein device identification and detail information includes operating system software installed on the devices (column 2, lines 32-40)

Pulsipher and Steele do not expressly disclose wherein the device identification and detail information includes device characteristics including amount of RAM and versions of operating systems and application software, however, Pulsipher and Steele do disclose wherein the device identification and detail information includes device characteristics, application software, and operating system information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to that the device identification and detail information may include such specific aspects such as software and operating system version numbers and device characteristics such as the amount of RAM on a device since these were well known specific instances of such device characteristics and software detail information to those skilled in the art and one of ordinary skill, given a group of specific device

characteristics and detail information, would have selected these specific elements and would have reasonably expected the system to operate in the same expected manner as disclosed in Pulsipher and Steele and such specific elements would not be critical to the operation of the system of the references such that these differences would be obvious in consideration of the operation of the claimed invention and the system of Pulsipher and Steele.

Claims 8, 14, 20, and 26 are also rejected since these claims recite a system, method, program product, and computer system that contain substantially the same limitations as recited in claim 4.

Regarding claim 5, Pulsipher discloses the system of claim 4 wherein the generated mapping report includes the device identities, device types, the device addresses, the device characteristics, the software installed on the devices, and the software characteristics. (column 7, line 65-column 8, line 6; column 8, lines 38-49, specifically "topology data")

Pulsipher does not disclose wherein the generated mapping report includes operating system software installed on the devices, however, Pulsipher does disclose wherein the device may be a computer (column 7, line 67-column 8, line 2, specifically column 8, line 1).

Steele discloses wherein a generated mapping report includes operating system software installed on the devices (column 2, lines 13-15 and 32-40)

Claim 5 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 5.

Claims 9, 21, and 27 are also rejected since these claims recite a system, method, program product, and computer system that contain substantially the same limitations as recited in claim 5.

Regarding claim 6, Pulsipher and Steele disclosed the system of claim 1.

Pulsipher disclosed the system further comprising a permission system for gaining user access to the network. (column 6, lines 11-35 and 62-64)

Regarding claim 10, Pulsipher and Steele disclosed the system of claim 1.

Pulsipher disclosed wherein the report system outputs the generated report. (column 8, lines 38-49 and 52-54, specifically lines 41-49 and 52-54)

Claim 7 is rejected since claim 7 recites a system that contains substantially the same limitations as recited in claims 1 and 3 in combination.

Claim 11 is rejected since this claim recites a system that contains substantially the same limitations as recited in claim 6.

Claims 17, 19 and 22 are rejected since these claims recite a program product that contains substantially the same limitations as recited in claims 1, 3 and 6 respectively.

Claims 23, 25 and 28 are rejected since these claims recite a computer system that contains substantially the same limitations as recited in claims 1, 3 and 6 respectively.

Regarding claim 12, Pulsipher disclosed a method for mapping a network, comprising the steps of:

installing collection tools on a collection apparatus; (column 6, lines 52-59)

communicating the collection apparatus with the network; (column 6, lines 26-28 and 36-45)

operating the collection tools to collect device identification and detail information from devices on the network by querying each device to retrieve the device identification and detail information (column 7, lines 41-57), wherein the detail information includes device characteristic information and software information (column 7, line 65-column 8, line 6);

analyzing the device identification and detail information; (column 8, lines 7-24)
and

reporting the analyzed device identification and detail information. (column 8, lines 38-49)

Regarding claim 13, Pulsipher disclosed the system of claim 12.

Pulsipher disclosed wherein the collection apparatus comprises at least one processor. (column 6, lines 19-20)

Regarding claim 15, Pulsipher disclosed the system of claim 12.

Pulsipher disclosed wherein the analyzing step further the step of resolving any conflicts between device identification and detail information collected by different collection tools. (column 11, lines 8-19)

Regarding claim 16, Pulsipher disclosed the system of claim 12.

Pulsipher disclosed wherein the reporting step comprises the step of generating a mapping report based on the analyzed device identification and detail information. (column 8, lines 38-49)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.